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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,324	05/31/2001	John Wnek	02125-P0027B	2237

27572 7590 03/04/2004

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BLOOMFIELD HILLS, MI 48303

EXAMINER
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JOHNSON, JONATHAN J

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 03/04/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,324	05/31/2001	John Wnek	02125-P00278	2237

25572 7590 04/18/2003

THE MEAD CORPORATION  
LEGAL DEPARTMENT  
4850D NORTH CHURCH LANE  
SMYRNA, GA 30080

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**Office Action Summary**

Application No.

09/871,324

Applicant(s)

WNEK ET AL.

Examiner

Jonathan Johnson

Art Unit

1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11-19-02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-27 is/are pending in the application.
- 4a) Of the above claim(s) 12,15,17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11,13,14,16 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-27 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I, Claims 13, 14, and 16 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

This application contains claims 12, 15, 17, and 18 are drawn to a nonelected invention in Paper No.7. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 13-14, 16, 19-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Nuss (4,869,419). Nuss teaches an ultrasonically agitated welding tip having a welding surface which extends in a plane (Figure 2, Item 1); a tip guide juxtaposed with the welding tip and having a guide surface extending perpendicular to the welding surface (Figure 1, Item 8); an anvil atop of the tip guide and having an anvil surface extending parallel to the welding surface (Figure 1, Item 7); and a gathering block having a gathering surface extending parallel to the

guide surface (Figure 1, Item 3 and 4 and Column 10, Lines 10-15); and a controller to move the gathering block (Claim 3 and Column 3, Lines 35 through Column 4, Line 30). It is the examiner's position that how the blocks are moved and how the controller operates are process limitations that hold little patentable weight in an apparatus claim.

### ***Response to Arguments***

Applicant argues Nuss does not teach either a controller. The examiner disagrees. As stated in the previous office action, this limitation can be found in Claim 3 and Column 3, Lines 35 through Column 4, Line 30 of Nuss.

In response to applicant's argument the operation of the machine should be given full patentable weight in an apparatus claim, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Put simply, applicant must establish a structural difference between the instant invention and the prior art. The examiner would like to note that applicant has not attempted to argue or show that the apparatus of Nuss is not capable of performing the in claimed manner.

Finally, applicant cites In re Swinehart and Sfiligoj, to show that functional limitations must be given full patentable weight. 169 USPQ 226 (1971). The examiner disagrees. It is the examiner's position that applicant has mischaracterized the holding of the case. In re Swinehart and Sfiligoj involves the U.S. Court of Customs and Patent Appeals (CCPA) reversing the Patent Office Board of Appeals finding that the use of functional language, per se, renders the claim indefinite. Id. at 228. The CCPA held that there were no per se grounds for rejecting a claim under 35 U.S.C. 112 on the basis of functional language. Id. The examiner would like to point out that in the instant case no rejections have been made -- functional language rejections or otherwise-- under 35 U.S.C. 112. The examiner recognizes that the claims in the instant application are sufficiently definite to provide a clear-cut indication of the scope of subject matter embraced by the claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Johnson whose telephone number is 703-308-0667. The examiner can normally be reached on M-Th 7AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 703-308-3318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

jj  
March 20, 2003

  
ALEXANDRA ELVE  
PRIMARY EXAMINER